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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/783,076
Filing Date: February 20, 2004
Appellant(s): WATTS ET AL.

MAILED
SEP 25 2007
GROUP 1700

Douglas E. Winters
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed August 15, 2007 appealing from the Office action mailed August 23, 2006.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

GROUND OF REJECTION NOT ON REVIEW

The following grounds of rejection have not been withdrawn by the examiner, but they are not under review on appeal because they have not been presented for review in the appellant's brief: 1) The rejection of claims 35-37 under 35 U.S.C. 103(a) as being unpatentable over Bomboire (U.S. Patent No. 4,089,724), 2) The rejection of claim 40 under 35 U.S.C. 103(a) as being unpatentable over Bomboire in view of Schmidle et al. (U.S. Patent No. 4,273,819), and 3) The rejection of claim 44 under 35 U.S.C. 103(a) as being unpatentable over Bomboire.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

4,089,724	Bomboire	5-1978
4,273,819	Schmidle et al.	6-1981

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 34, 38, 39, 41-43, 47 and 48 stand rejected under 35 U.S.C. 102(b) as being anticipated by Bomboire (US 4,089,724).

Regarding claim 34, Bomboire discloses a coated freestanding film consisting essentially of a freestanding film having opposed first and second sides (Fig. 2, element 41); a print layer having a printed pattern or design, the print layer being disposed on the first side of the film (Fig. 2, element 31) and a discontinuous layer forming a pattern or design disposed on the second side of the film (Fig. 2, element 33; also see col. 5, lines 1-5) having a gloss level different from the gloss level of the second side of the film (see col. 5, lines 23-34). It is to be pointed out that the phrase “consisting essentially of” is being construed as equivalent to “comprising”.

Regarding claim 38, the print layer is at least partially viewable through the film (see col. 5, lines 1-5). Regarding claims 39 and 47, the discontinuous layer comprises first and second portions, the first portion having a gloss level different from the gloss level of the second portion (see col. 8, lines 66-68). Regarding claim 41, the film comprises a plurality of film layers (see col. 5, line 46). Regarding claim 42, the discontinuous layer has a portion in-register with a portion of the printed pattern or design (see col. 4, lines 21-27). Regarding claim 43, the film is a rigid or semi-rigid film (see col. 8, lines 8-9 and col. 9, lines 35-40). Regarding claim 48, the discontinuous layer comprises a flattening agent, a texturing agent and combinations thereof (see col. 8, lines 15-22).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 35-37 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Bomboire (US 4,089,724).

Bomboire discloses a coated freestanding film consisting essentially of a freestanding film having opposed first and second sides (Fig. 2, element 41); a print layer having a printed pattern or design, the print layer being disposed on the first side of the film (Fig. 2, element 31) and a discontinuous layer forming a pattern or design disposed on the second side of the film

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(Fig. 2, element 33; also see col. 5, lines 1-5) having a gloss level different from the gloss level of the second side of the film (see col. 5, lines 23-34). Although Bomboire does teach a thickness of the discontinuous layer (see col. 9, lines 60-62), Bomboire fails to teach the discontinuous layer having a thickness between about 0.1 mils and less than about 0.5 mils, about 0.1 mils and about 0.45 mils and about 0.1 mils and about 0.4 mils. The optimum ranges for the thickness of the discontinuous layer would be readily determined through routine experimentation by one having ordinary skill in the art depending on the desired end results. Therefore, it would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have modified the thickness of the discontinuous layer in Bomboire to have a thickness between about 0.1 mils and less than about 0.5 mils, about 0.1 mils and about 0.45 mils and about 0.1 mils and about 0.4 mils, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art in absence of showing unexpected results. *MPEP 2144.05 (II)*.

Claim 40 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Bomboire (US 4,089,724) in view of Schmidle et al. (US 4,273,819).

Bomboire discloses a coated freestanding film consisting essentially of a freestanding film having opposed first and second sides (Fig. 2, element 41); a print layer having a printed pattern or design, the print layer being disposed on the first side of the film (Fig. 2, element 31) and a discontinuous layer forming a pattern or design disposed on the second side of the film (Fig. 2, element 33; also see col. 5, lines 1-5) having a gloss level different from the gloss level of the first and second side of the film (see col. 5, lines 23-34). However, Bomboire fails to teach the print layer comprising a chemical embossing agent. Schmidle et al. teaches that it is well

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known in the art to have a print layer comprise a chemical embossing agent (see col. 13, lines 47-64) for the purpose of producing a chemical embossed pattern. Therefore, it would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have modified the print layer in Bomboire to comprise a chemical embossing agent as suggested by Schmidle et al. in order to provide a chemical embossed pattern.

Claims 45, 46 and 49 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Bomboire (US 4,089,724) in view of Schmidle et al. (US 4,273,819).

Bomboire discloses a coated freestanding film consisting essentially of a freestanding film having opposed first and second sides (Fig. 2, element 41); a print layer having a printed pattern or design, the print layer being disposed on the first side of the film (Fig. 2, element 31) and a discontinuous layer forming a pattern or design disposed on the second side of the film (Fig. 2, element 33; also see col. 5, lines 1-5) having a gloss level different from the gloss level of the first and second side of the film (see col. 5, lines 23-34). It is to be pointed out that the phrase "consisting essentially of" is being construed as equivalent to "comprising".

However, Bomboire fails to disclose the film having a mechanically embossed surface texture and the mechanically embossed surface texture of the film being in-register with the pattern or design of the discontinuous layer.

Schmidle et al. teaches that it is well known in the art to mechanically emboss the surface of a wear layer of a differential gloss decorative sheet for the purpose of providing a flat, dead or dull mat finish or texture which is roughened, textured, corrugated, contoured, knurled, lined or the like.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have provided the film in Bomboire with a mechanically embossed surface texture and have the mechanically embossed surface texture in-register with the pattern or design of the discontinuous layer as suggested by Schmidle et al. in order to provide a flat, dead or dull mat finish or texture which is roughened, textured, corrugated, contoured, knurled, lined or the like.

Claim 44 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Bomboire (US 4,089,724).

Bomboire discloses a coated freestanding film consisting essentially of a freestanding film having opposed first and second sides (Fig. 2, element 41); a print layer having a printed pattern or design, the print layer being disposed on the first side of the film (Fig. 2, element 31) and a discontinuous layer forming a pattern or design disposed on the second side of the film (Fig. 2, element 33; also see col. 5, lines 1-5) having a gloss level different from the gloss level of the first and second side of the film (see col. 5, lines 23-34). Although Bomboire teaches a vinyl film having plasticizer (see col. 9, lines 10-12), Bomboire fails to teach the vinyl film having less than 5 parts plasticizer per hundred parts by weight of the vinyl resin. The optimum range for the plasticizer would be readily determined through routine experimentation by one having ordinary skill in the art depending on the desired end results. Therefore, it would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have modified the plasticizer in the vinyl resin of the film in Bomboire to be less than 5 parts per hundred parts by weight of the vinyl resin, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges

involves only routine skill in the art in absence of showing unexpected results. *MPEP 2144.05* (II).

(10) Response to Argument

Rejection of claims 34, 38, 39, 41-43, 47 and 48 under 35 U.S.C. 102(b) as anticipated by

Bomboire

Appellants' argue "Bomboire does not teach or suggest a freestanding film having a print layer and a discontinuous layer, as required by claim 34".

However, Bomboire clearly teaches the structure of the freestanding film as recited in claim 34. Bomboire clearly teaches a print layer (Fig. 2, element 31) disposed on the first side of the film (Fig. 2, element 41) and a discontinuous layer (Fig. 2, element 33) disposed on the second side of the film (Fig. 2, element 41).

Appellants' then argue "the support or base 1 of Bomboire materially changes the aforementioned basic and novel characteristics of the Applicants' invention. The structure taught in Bomboire is a surface covering, particularly a floor or wall covering, and not a freestanding film, which is subsequently laminated to a surface covering substrate to form the surface covering".

However, it is to be pointed out that no evidence has been provided to show that the presence of such a support or base 1 taught in Bomboire would materially affect the basic and novel characteristics of the claimed invention. Applicants' state that "the basic and novel characteristics of the claimed invention is set forth in paragraph 7 of the specification, i.e. to meet the "need for a surface covering which has a differential gloss effect printed onto a film which is in-register with a printed or a mechanically embossed pattern or design thereon".

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However, Bomboire clearly teaches a surface covering (col. 1, line 18) and the surface covering (Fig. 2) in Bomboire is clearly taught to have a differential gloss effect 33 printed onto a film 41 which is in-register with a printed pattern 31 thereon (col. 5, lines 19-22 and 24-34). Thus, the surface covering in Bomboire appears to have the same basic and novel characteristics as that of the claimed invention. So it is unclear to the Examiner how the support or base 1 of Bomboire would materially change the basic and novel characteristics of Applicant's claimed invention. Again, Applicants' have provided no evidence that the presence of such a support or base would materially affect the basic and novel characteristics of the claimed invention. Therefore, the phrase "consisting essentially of" in claim 34 is still being construed as equivalent to "comprising". Thus, claim 34 is clearly anticipated by Bomboire.

Appellants' further argue Bomboire does not teach or suggest a plurality of film layers as recited in present claim 41.

However, it is to be pointed out that the surface covering in Bomboire can include a plurality of film layers (col. 3, lines 4-6 and col. 5, lines 44-46) and therefore claim 41 is clearly anticipated by Bomboire.

Rejection of claim 49 under 35 U.S.C. 103(a) over Bomboire in view of Schmidle

Appellants' state "the arguments set forth above with respect to claim 34 apply with equal force to the rejection of claim 49".

Therefore, it is to be pointed out again that no evidence has been provided to show that the presence of such a support or base 1 taught in Bomboire would materially affect the basic and novel characteristics of the claimed invention. Applicants' stated that "the basic and novel characteristics of the claimed invention is set forth in paragraph 7 of the specification, i.e. to


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meet the “need for a surface covering which has a differential gloss effect printed onto a film which is in-register with a printed or a mechanically embossed pattern or design thereon”.

However, Bomboire clearly teaches a surface covering (col. 1, line 18) and the surface covering (Fig. 2) in Bomboire clearly is taught to have a differential gloss effect 33 printed onto a film 41 which is in-register with a printed pattern 31 thereon (col. 5, lines 19-22 and 24-34). Thus, the surface covering in Bomboire appears to have the same basic and novel characteristics as that of the claimed invention. So it is unclear to the Examiner how the support or base 1 of Bomboire would materially change the basic and novel characteristics of Applicant's claimed invention. Again, Applicants' have not provided any evidence that the presence of such a support or base as disclosed in Bomboire would materially affect the basic and novel characteristics of the claimed invention. Therefore, the phrase “consisting essentially of” in claim 49 is still being construed as equivalent to “comprising”. Thus, claim 49 fails to patentably define over the prior art (Bomboire and Schmidle).

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.


RENA DYE
SUPERVISORY PATENT EXAMINER
AU 1772

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For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Catherine A. Simone/

Catherine A. Simone

September 19, 2007

Conferees:

Rena Dye 


Romulo Delmendo